

Appl.No.10/696,906
Response Dated March 10, 2005
Final Office Action of January 10, 2005

REMARKS

Consideration of IDS Requested

Consideration of the Information Disclosure Statement filed February 24, 2004 is respectfully requested.

The Objection To Claim 20 Is Overcome.

Claim 20 was objected to because it does not end in a period. Claim 20 is herein amended to end in a period. Reconsideration and withdrawal of the objection is, therefore, respectfully requested.

The Subject Matter of Claims 1-7, 15, 16 and 17 Is Not Suggested By The Combination of The '192 Patent to Caccamo and The '880 Patent to Sugimoto.

Claims 1-7, 15, 16 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Caccamo (U.S. Patent No. 3,768,192) in view of Sugimoto (U.S. Patent No. 5,956,880). This rejection is respectfully traversed.

Applicant initially notes that the patent to Caccamo does not teach or suggest a waterfowl luring apparatus having a rotatable platform, a force-generating unit for rotating the rotatable platform, a power source for powering the force-generating unit to rotate the rotatable platform, one or more support arms attached to the rotatable platform, or a waterfowl decoy attached to the upper end of each support arm and positioned above the rotatable platform so that the decoy is moved along a substantially circular path above the rotatable platform as the rotatable platform is rotated by the force-generating unit, as specifically called for in Claim 1. Caccamo teaches a totally passive device that uses wind to animate a decoy attached to the end of a flexible arm. The decoys are mounted to one end of the flexible arm with a pivoting type mount that allows the decoy to pivot about a vertical axis in response to wind. The other end of the flexible arm is supported by a pipe driven into the earth. The decoy can bob up and down and pivot about the vertical axis in response to wind, but unlike the claimed invention the decoy cannot circle or fly through the air even when wind is present. When wind is not present, the decoy sits motionless as though suspended in mid-air.

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Motion of the decoys is at all time completely dependent upon wind conditions – a significant disadvantage of which the present invention does not suffer.

Nor does the '880 patent to Sugimoto cure the many deficiencies of the passive Caccamo device. Sugimoto describes a bird repelling device that uses a motor to rotate a decoy of a raptor to scare off birds like crows and doves. To enhance its scaring effect, the raptor decoy is fitted with blinking red eyes, a permanent magnet or ultrasonic transmitter, and a sound generator. In stark contrast to Sugimoto, the claimed invention operates to lure birds, not scare them. The Sugimoto decoy is attached for rotation to the motor by a suspension wire, and the motor unit is attached to a building by a support member. A reel around which the suspension wire is wound allows the length of the suspension wire to be controlled so as to vary the size of the hemispherical body B (Figure 2).

By varying the rotational speed of the motor, the raptor decoy is caused to pass any point on the surface of the hemispherical body. Motor speed and suspension wire length are controlled by a computer so that flying behavior of an actual bird of prey is simulated. With this arrangement, the birds are prevented from being accustomed to the same flying trajectory pattern of the raptor decoy and the scaring effect of the device is increased. The device further includes a timer or light sensor, the output of which is used to turn off electrical power to the motor, reel, and power distribution panel during nighttime. An infrared sensor is also provided to sense the presence of birds and initiate operation of the device. In all embodiments described by Sugimoto, the flight path of the raptor decoy is limited to points at or below rotary body 6. Thus, Sugimoto does not teach or suggest a waterfowl luring apparatus of any kind, and more particularly does not teach or suggest a waterfowl luring apparatus having one or more support arms for moving waterfowl decoys along a substantially circular path above a rotatable platform as specifically called for in Claim 1.

The Examiner contends that "it would have been obvious to provide the decoy of Caccamo with a rotating platform, a force generating unit and a power source as shown by Sugimoto for the purpose of rotating the decoys in a circle to attract more waterfowl at times when wind and water power is not providing enough power." Applicant respectfully disagrees. The prior art (not the applicant) must provide the motivation to make the proposed modifications needed to arrive at the claimed invention, and there is no such motivation provided by Caccamo or Sugimoto. In fact, these

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references actually teach away from the proposed combination. The principal object of the Caccamo device is "the provision of a simple yet effective means for mounting a conventional and existing decoy in a manner to achieve animated action thereof in accordance with various wind conditions." (See column 1, lines 47-51) The combination proposed by the Examiner would subvert this principal object of the Caccamo device in at least two ways. First, incorporating Sugimoto's motorized, computerized, flashing red-eyed, screeching, ultrasonic-transmitting, bird-scaring device into the bird-luring device of Caccamo would complicate the Caccamo device and render it no longer "simple." Second, motorizing the Caccamo device would mean that it is no longer animated by wind conditions. Clearly, the Caccamo device contemplates a simple, passive device that uses wind (not motors or computers) to animate the decoy. To animate the decoys with a computer-controlled, multi-speed motor as proposed by the Examiner would be antithetical to the express teachings of Caccamo and render it non-functional with respect to its expressly stated principal object.

Even when the Caccamo and Sugimoto devices are combined, the claimed invention does not result. The Sugimoto device teaches use of a suspension wire to fly a raptor decoy at or below the point at which the wire is attached for rotation by the motor. When the raptor decoy of Sugimoto is replaced by the waterfowl decoy of Caccamo, the waterfowl decoy will also fly at or below the point at which the suspension wire is attached for rotation by the motor. This is clearly different than the claimed invention. Waterfowl intended to be lured by such a device will more likely be alarmed or scared because when the decoy is not positioned above the motor attachment point, the motor and other non-luring structure is more readily observable by waterfowl. While this is not a concern in a device that is intended to scare birds, it is certainly a concern for devices that are intended to lure waterfowl (which are easily scared), and neither reference provides any recognition or solution to this problem. Additionally, if the flexible arm and decoy of Caccamo were somehow incorporated into the motorized device described by Sugimoto (and there is no teaching or suggestion whatsoever in either of the references as to why or how this would be done), the result would be a device that scares waterfowl because the decoys of Caccamo are attached to the arms in a way that causes the decoys to pivot about an axis perpendicular to the flexible arm. This would produce a rotating, spinning decoy that is unlike any duck or other waterfowl that Applicant has ever seen fly. In short, substantial non-

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obvious modification of the combined teachings of these two references would be required to arrive at Applicant's invention as claimed.

There is a further fatal flaw in the rejection in terms of the combinability of Caccamo and Sugimoto. It is well established in the law governing questions of obviousness that there must be some explicit teaching or suggestion in the art to motivate one of even ordinary skill to combine the elements in the manner proposed by the Examiner so as to create the same invention. Winner Int'l Royalty Corp. v. Wang, 48 USPQ2d 1139 (D.C.D.C. 1998). Otherwise, the combination cannot have been obvious. Here, we have one reference, Caccamo, which employs a simple, passive system that uses wind to animate a decoy for the purpose of luring waterfowl (unlike that claimed by Applicant) combined with another reference, Sugimoto, which employs a complex, active system for the purpose of scaring fowl (also unlike that claimed by Applicant). It is apparent that these two references rely on completely divergent approaches as they attempt to invoke completely different solutions for completely different problems. The considerations involved in scaring birds which dictated the approach employed by Sugimoto are totally unlike the considerations which dictated the approach employed by Caccamo for luring birds.

There is no objectively reasonable basis to assert that the person of ordinary skill attempting to solve the myriad of problems associated with a waterfowl luring apparatus would combine only those elements selected by the Examiner from a passive waterfowl-luring device and an active bird-scaring device. This is especially true when the systems are based on fundamentally different solutions to fundamentally different problems. The reference teachings are simply not "obviously" combinable by any stretch of the imagination. Given the lack of any express teaching or even an implicit suggestion to combine these two references in the proposed manner, it appears that hindsight knowledge of Applicant's invention has been employed.

For the above reasons, it is apparent that the subject matter of Claim 1 defines a patentable advance over the prior art. Withdrawal of the rejection and allowance of Claim 1 is, therefore, respectfully requested.

Turning now to dependent Claims 2-7 and 15, each of these dependent claims further limit an allowable claim in ways that are neither taught or suggested by the prior art and are therefore

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allowable. Accordingly, reconsideration and allowance of Claim 2-7 and 15 is respectfully requested.

Claim 16 incorporates all of the limitations of Claim 1 and is therefore allowable for the reasons discussed above. To avoid repetition, that discussion is hereby adopted and asserted against the rejection of Claim 16 over the combination of Caccamo and Sugimoto.

Claim 17 further limits an allowable claim in ways that are neither taught or suggested by the prior art, and is therefore allowable.

Reconsideration and allowance of Claims 16-17 is respectfully requested.

The Subject Matter of Claims 8-14 and 18-20 Is Not Suggested By The Combination of Caccamo, Sugimoto and The '983 Application of Porter.

Claims 8-14 and 18-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Caccamo, Sugimoto and Porter (U.S. Patent Application Publication No. US 2003/0204983 A1). This rejection is respectfully traversed.

Applicant initially notes that neither Caccamo nor Sugimoto, either singly or in combination, teach or suggest a waterfowl luring device as specifically required by independent Claims 1 and 16, from which Claims 8-14 and 18 depend. As discussed above, Caccamo does not teach or suggest a waterfowl luring device having a rotatable platform, a force-generating unit for rotating the rotatable platform, a power source for powering the force-generating unit to rotate the rotatable platform, one or more support arms attached to the rotatable platform, or a waterfowl decoy attached to the upper end of each support arm and positioned above the rotatable platform so that the decoy is moved along a substantially circular path above the rotatable platform as the rotatable platform is rotated by the force-generating unit, as specifically called for in Claims 1 and 16. Additionally, as discussed above, the teachings of Caccamo are inapposite to the teachings of Sugimoto, and even if one did make the cited combination in the particular manner proposed by the Examiner, the claimed invention does not result. To avoid duplicating all of the above discussion, that discussion is hereby adopted and reasserted against the rejection of Claims 8-14 and 18.

Porter does nothing to cure the deficiencies of Caccamo and Sugimoto. Porter describes a

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waterfowl decoy with rotating wings mounted to a floating frame. A pull cord is manually operated by the user to rotate the wings of the decoy. The Porter decoy does not teach or suggest a buoyant housing to which the claimed force-generating unit is attached (Claims 8 and 18), does not teach or suggest rigid attachment of the claimed rotatable platform to the housing (Claim 9), does not teach or suggest a floatation device operably associated with the buoyant housing for enhancing buoyancy (Claim 10), does not teach or suggest one or more hydrodynamic drag inducing elements attached to an outer surface of the buoyant housing (Claim 11), does not teach or suggest a power supply or a force-generating unit positioned with the buoyant housing (Claims 12 and 13), and does not teach or suggest a force-generating unit attached to an outer surface of the buoyant housing (Claim 14). As explicitly stated by Porter, an object of the Porter device is "to provide a waterfowl decoy that moves without the need of a motor" and "where movement may be controlled by a human operator." (See paragraphs 0015 and 0017)

As with the combination of Caccamo and Sugimoto, the Examiner again appears to have impermissible hindsight knowledge of Applicant's invention appears to have been employed to pick and choose only certain elements of the prior art and then combine those carefully selected elements in a way that leads to something resembling what Applicant is claiming, without regard to the explicit teachings of the references. This is evident from the reasoning given in the Office Action. For example, paragraph 3 of the Office Action states "it would have been obvious to mount the decoy and housing of Caccamo as modified by Sugimoto on a buoyant housing as shown by Porter to use the unit in water too deep to sink a pipe into the ground." As an initial matter, the bird-repelling device of Sugimoto does not suggest modification of the bird-attracting device of Caccamo. And there is nothing in any of the cited references to suggest that Caccamo should be modified in a way that it can be used in deep water. Porter itself does not even state that the device is intended for use in deep water. Nor is deep water use a stated object of the Porter invention. As explained above, there must be some explicit teaching or suggestion in the art to motivate one of even ordinary skill to combine the elements in the manner proposed by the Examiner so as to create the same invention. Winner Int'l Royalty Corp. v. Wang, 48 USPQ2d 1139 (D.C.D.C. 1998). In the absence of such an explicit teaching or suggestion, as we have here, the combination cannot be considered obvious.

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Thus, Claims 1 and 16 are allowable.

Claims 8-14 and 18 further limit an allowable claim in ways that are neither taught or suggested by the prior art and are allowable for this reason as well. Reconsideration and allowance of Claims 8-14 and 18 is, therefore, respectfully requested.

Claim 19 incorporates all of the limitations of Claims 1 and 16 and is therefore allowable for the reasons discussed above. To avoid repetition, that discussion is hereby adopted and asserted against the rejection of Claim 19 over the combination of Caccamo, Sugimoto and Porter.

Claim 19 further requires "a buoyant housing to which said force-generating unit is attached." Nothing in the cited references teaches or suggests attaching the claimed force-generating unit to a buoyant housing. Porter teaches mounting a human-operated decoy to a floating frame, and specifically teaches away from mounting any type of powered force-generating unit to the unit when he states that an object of the Porter device is "to provide a waterfowl decoy that moves without the need of a motor" and "where movement may be controlled by a human operator." (See paragraphs 0015 and 0017) Caccamo also teaches away from the use of a powered force-generating unit when he states that the principal object of the Caccamo device is "the provision of a simple yet effective means for mounting a conventional and existing decoy in a manner to achieve animated action thereof in accordance with various wind conditions." (See column 1, lines 47-51) Modification of the Caccamo and Porter devices in the proposed manner would be antithetical to the wind-powered and human-powered solutions taught by these references.

For all the above reasons, Claim 19 is allowable over the cited combination and such action is respectfully requested.

Claim 20 further limits an allowable claim in a way that is neither taught or suggested by the prior art. There is no teaching or suggestion whatsoever of operably associating a floatation device with the claimed buoyant housing. Reconsideration and allowance of Claim 20, therefore, is respectfully requested.

The Subject Matter of Claims 1-7 and 15-17 Is Not Suggested By The Combination of The '192 Patent to Caccamo and The '880 Patent to Sugimoto.

Claims 1-7 and 15-17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over
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Sugimoto in view of Caccamo. This rejection is respectfully traversed.

The teachings of Sugimoto and Caccamo are discussed at length hereinabove. To avoid repetition, that discussion is hereby adopted and reasserted against the rejection of Claims 1-7 and 15-17.

The Examiner contends that "it would have been obvious to provide the decoy of Sugimoto with arms extending above the platform as shown by Caccamo for the purpose of using the device in locations where a top mount is not practical by mounting the rotatable platform and box from the bottom." Applicant respectfully disagrees. Sugimoto describes several embodiments of his bird-scaring device, including an embodiment where the rotary body and box are mounted from the bottom (See Figure 3). Thus, the motivation provided in the Office Action for combining these two references in the proposed manner is nonexistent. As explained above, the prior art (not the applicant) must provide the motivation to make the proposed modifications needed to arrive at the claimed invention, and there is no such motivation provided by Sugimoto or Caccamo. In fact, these references actually teach away from the proposed combination. In all embodiments, Sugimoto teaches a bird-scaring device that uses a computer-controlled, motorized configuration to fly a raptor decoy at or below the point at which the suspension wire is attached for rotation by the motor. Where is the motivation for Sugimoto to replace the suspension wire and motor-operated raptor decoy with the flexible arm and wind-powered waterfowl decoy of Caccamo? It does not exist, either expressly or implicitly in either of these references. The object of all embodiments of the Sugimoto device is to scare birds. To transform the Sugimoto bird-scaring device into a bird-luring device, as suggested in the Office Action, would be antithetical to the express teachings of Sugimoto and render it non-functional with respect to its intended purpose.

Even when the Sugimoto and Caccamo devices are combined, the claimed invention does not result. The Sugimoto device teaches use of a suspension wire to fly a raptor decoy at or below the point at which the wire is attached for rotation by the motor. When the raptor decoy of Sugimoto is replaced by the waterfowl decoy of Caccamo, the waterfowl decoy will also fly at or below the point at which the suspension wire is attached for rotation by the motor. This is clearly different than the claimed invention. Waterfowl intended to be lured by such a device will more likely be alarmed or

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scared because when the decoy is not positioned above the motor attachment point, the motor and other non-luring structure is more readily observable by waterfowl. While this is not a concern in a device that is intended to scare birds, it is certainly a concern for devices that are intended to lure waterfowl (which are easily scared), and neither reference provides any recognition or solution to this problem. Additionally, if the flexible arm and decoy of Caccamo were somehow incorporated into the motorized device described by Sugimoto (and there is no teaching or suggestion whatsoever in either of the references as to why or how this would be done), the result would be a device that scares waterfowl because the decoys of Caccamo are attached to the arms in a way that causes the decoys to pivot about an axis perpendicular to the flexible arm. This would produce a rotating, spinning decoy that is unlike any duck or other waterfowl that Applicant has ever seen fly. In short, substantial non-obvious modification of the combined teachings of these two references would be required to arrive at Applicant's invention as claimed.

There is a further fatal flaw in the rejection in terms of the combinability of Sugimoto and Caccamo. It is well established in the law governing questions of obviousness that there must be some explicit teaching or suggestion in the art to motivate one of even ordinary skill to combine the elements in the manner proposed by the Examiner so as to create the same invention. Winner Int'l Royalty Corp. v. Wang, 48 USPQ2d 1139 (D.C.D.C. 1998). Otherwise, the combination cannot have been obvious. Here, we have one reference, Caccamo, which employs a simple, passive system that uses wind to animate a decoy for the purpose of luring waterfowl (unlike that claimed by Applicant) combined with another reference, Sugimoto, which employs a complex, active system for the purpose of scaring fowl (also unlike that claimed by Applicant). It is apparent that these two references rely on completely divergent approaches as they attempt to invoke completely different solutions for completely different problems. The considerations involved in scaring birds which dictated the approach employed by Sugimoto are totally unlike the considerations which dictated the approach employed by Caccamo for luring birds.

There is no objectively reasonable basis to assert that the person of ordinary skill attempting to solve the myriad of problems associated with a waterfowl luring apparatus would combine only those elements selected by the Examiner from a passive waterfowl-luring device and an active bird-

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scaring device. This is especially true when the systems are based on fundamentally different solutions to fundamentally different problems. The reference teachings are simply not "obviously" combinable by any stretch of the imagination. Given the lack of any express teaching or even an implicit suggestion to combine these two references in the proposed manner, it appears that hindsight knowledge of Applicant's invention has been employed.

For the above reasons, it is apparent that the subject matter of Claims 1 and 16 define a patentable advance over the prior art. Withdrawal of the rejection and allowance of Claims 1 and 16 is, therefore, respectfully requested.

Turning now to dependent Claims 2-7, 15 and 17 each of these dependent claims further limit an allowable claim in ways that are neither taught or suggested by the prior art and are therefore allowable. Accordingly, reconsideration and allowance of Claim 2-7, 15 and 17 is respectfully requested.

The Subject Matter of Claims 8-14 and 18-20 Is Not Suggested By The Combination of Sugimoto, Caccamo and Porter.

Claims 8-14 and 18-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Caccamo, Sugimoto and Porter (U.S. Patent Application Publication No. US 2003/0204983 A1). This rejection is respectfully traversed.

Applicant initially notes that neither Sugimoto nor Caccamo, either singly or in combination, teach or suggest a waterfowl luring device as specifically required by independent Claims 1 and 16, from which Claims 8-14 and 18 depend. As discussed above, Sugimoto does not teach or suggest a waterfowl luring device having a waterfowl decoy attached to the upper end of a support arm and positioned above a rotatable platform so that the decoy is moved along a substantially circular path above the rotatable platform as the rotatable platform is rotated by a force-generating unit, as specifically called for in Claims 1 and 16. Additionally, as discussed above, the teachings of Sugimoto are inapposite to the teachings of Caccamo, and even if one did make the cited combination in the particular manner proposed by the Examiner, the claimed invention does not result. To avoid duplicating all of the above discussion, that discussion is hereby adopted and

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reasserted against the rejection of Claims 8-14 and 18.

Porter does nothing to cure the deficiencies of Sugimoto and Caccamo. Porter describes a waterfowl decoy with rotating wings mounted to a floating frame. A pull cord is manually operated by the user to rotate the wings of the decoy. The Porter decoy does not teach or suggest a buoyant housing to which the claimed force-generating unit is attached (Claims 8 and 18), does not teach or suggest rigid attachment of the claimed rotatable platform to the housing (Claim 9), does not teach or suggest a floatation device operably associated with the buoyant housing for enhancing buoyancy (Claim 10), does not teach or suggest one or more hydrodynamic drag inducing elements attached to an outer surface of the buoyant housing (Claim 11), does not teach or suggest a power supply or a force-generating unit positioned with the buoyant housing (Claims 12 and 13), and does not teach or suggest a force-generating unit attached to an outer surface of the buoyant housing (Claim 14). As explicitly stated by Porter, an object of the Porter device is "to provide a waterfowl decoy that moves without the need of a motor" and "where movement may be controlled by a human operator." (See paragraphs 0015 and 0017)

As with the combination of Sugimoto and Caccamo, the Examiner again appears to have employed impermissible hindsight knowledge of Applicant's invention to pick and choose only certain elements of the prior art and then combine those carefully selected elements in a way that leads to something resembling what Applicant is claiming, without regard to the explicit teachings of the references. This is evident from the reasoning given in the Office Action. For example, paragraph 5 of the Office Action states "it would have been obvious to provide the decoy of Sugimoto as modified by Caccamo with a floating platform as shown by Porter for the purpose of using the decoys in water too deep to drive a pole into the bottom." As an initial matter, the bird-luring device of Caccamo does not suggest modification of the bird-scaring device of Sugimoto. And there is nothing in any of the cited references to suggest that Sugimoto should be modified in a way that it can be used in deep water. The Sugimoto device is intended to scare birds away from buildings, and buildings are not normally built in deep water. Porter itself does not even state that the device is intended for use in deep water. Nor is deep water use a stated object of the Porter invention. As explained above, there must be some explicit teaching or suggestion in the art to

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motivate one of even ordinary skill to combine the elements in the manner proposed by the Examiner so as to create the same invention. Winner Int'l Royalty Corp. v. Wang, 48 USPQ2d 1139 (D.C.D.C. 1998). In the absence of such an explicit teaching or suggestion, as we have here, the combination cannot be considered obvious. Thus, Claims 1 and 16 are allowable.

Claims 8-14 and 18 further limit an allowable claim in ways that are neither taught or suggested by the prior art and are allowable for this reason as well. Reconsideration and allowance of Claims 8-14 and 18 is, therefore, respectfully requested.

Claim 19 incorporates all of the limitations of Claims 1 and 16 and is therefore allowable for the reasons discussed above. To avoid repetition, that discussion is hereby adopted and asserted against the rejection of Claim 19 over the combination of Sugimoto, Caccamo and Porter.

Claim 19 further requires "a buoyant housing to which said force-generating unit is attached." Nothing in the cited references teaches or suggests attaching the claimed force-generating unit to a buoyant housing. Porter teaches mounting a human-operated decoy to a floating frame, and specifically teaches away from mounting any type of powered force-generating unit to the unit when he states that an object of the Porter device is "to provide a waterfowl decoy that moves without the need of a motor" and "where movement may be controlled by a human operator." (See paragraphs 0015 and 0017) Caccamo also teaches away from the use of a powered force-generating unit when he states that the principal object of the Caccamo device is "the provision of a simple yet effective means for mounting a conventional and existing decoy in a manner to achieve animated action thereof in accordance with various wind conditions." (See column 1, lines 47-51) Modification of the Caccamo and Porter devices in the proposed manner would be antithetical to the wind-powered and human-powered solutions taught by these references.

For all the above reasons, Claim 19 is allowable over the cited combination and such action is respectfully requested.

Claim 20 further limits an allowable claim in a way that is neither taught or suggested by the prior art. There is no teaching or suggestion whatsoever of operably associating a floatation device with the claimed buoyant housing. Reconsideration and allowance of Claim 20, therefore, is respectfully requested.

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Comments on Response to Arguments

The Response to Argument section of the Final Office Action includes statements that take Applicant's arguments out of context. For example, the Response to Arguments states "one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references." Applicant has not read the individual references in isolation as implied. Rather, Applicant has read the references for what they fairly teach in combination with each other as a whole. This is evident in the discussion beginning at the first full paragraph of page 4 of the Response through the end of the first full paragraph on page 6. Within this discussion, Applicant specifically addresses "The combination proposed by the Examiner. . ." When references are addressed individually in the Response, it is for the perfectly valid purpose of demonstrating that the alleged teachings of the references are not present, and thus, the claimed invention is not obvious in view of the combination. See the first sentence of the first full paragraph of page 5 ("Even when the Caccamo and Sugimoto devices are combined, the claimed invention does not result.") Applicant has addressed the teachings of the cited references, both singly and in combination, in a manner that is clearly proper to show the complete lack of obviousness of Applicant's invention as claimed.

The Response to Arguments also states "As to the combination of Caccamo and Sugimoto no longer being simple, patentability is not determined on simplicity." Applicant has not argued that patentability exists because of simplicity *per se*, as implied in the Response to Arguments. Instead, Applicant has argued that patentability exists because of the express teachings of the references. Caccamo expressly teaches "a simple yet effective means for mounting a conventional and existing decoy in a manner to achieve animated action thereof in accordance with various wind conditions." (See column 1, lines 47-51) This express teaching must be taken into account when considering what the combined references teach as a whole. Clearly, Caccamo teaches away from the cited combination, and there is no express teaching or suggestion by Sugimoto to make the specific modifications to his bird-scaring device that have been proposed by the Examiner. Since one of the two references teaches away from the combination and the other reference is silent as to modification, it is clear to Applicant that the combined references, as a whole, do not suggest the claimed invention to those of ordinary skill. What is unclear to Applicant is how the Examiner has

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concluded that such a suggestion is present in the cited references.

The Examiner asserts on page 6 of the Final Office Action that obviousness is established in this case because "... the knowledge is generally available to one of ordinary skill in the art." No evidence has been offered by the Examiner to show what one skilled in the art would generally be aware of. The Federal Circuit recently held in a non-precedential ruling that information claimed by the Examiner to be well known in the industry but which was not supported in the record was an improper basis for finding motivation in the prior art to support a ruling of obviousness. (See In re Bruce Beasley (Fed. Cir. December 7, 2004) The court stated there must be some concrete evidence in the record showing what is recognized by one of skill. No such showing has been made by the Examiner in this case. Instead, the Examiner has relied on a naked assertion that the knowledge is somehow generally available. Applicant respectfully requests that the Examiner disclose the evidence he has relied on in making this statement if the rejection is to be maintained.

The Examiner states that "... it should be pointed out that a bird scaring device might scare some birds but attract other birds such as birds of prey." Where does such a teaching come from? Certainly not from either of the cited references. Again, the Examiner has made a naked, unsupported assertion that does not constitute a proper basis for finding that obviousness exists.

The Examiner further states "... making the decoy fly at a greater height with respect to the motor or housing would be an obvious manner of design choice since the arrangement of the location of the parts is obvious." The Examiner then attempts to support this statement by equating a pipe to a central (understood to mean "buoyant" as set forth in the claims) housing. Applicant's claimed buoyant housing floats. Pipes do not float. It is unclear to Applicant how it would be obvious to substitute a pipe with a buoyant housing. Where is the teaching or suggestion that would motivate one of skill to take the various elements of the references and combine them in the torturous manner proposed by the Examiner?

Finally, the Examiner states "It should be pointed out that Porter is cited simply to show a buoyant housing." Applicant respectfully submits that this statement supports Applicant's position that the Examiner has impermissibly used hindsight knowledge of Applicant's invention to pick and choose among the various elements of the disparate references in an attempt to recreate Applicant's

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invention and thereby conclude that it would have obvious. There is no teaching or suggestion in any of the cited references to motivate one of ordinary skill to combine Porter with Caccamo/Sugimoto (as modified by the Examiner) in the proposed manner.

Conclusion.

The Applicant has endeavored to address all of the Examiner's concerns expressed in the outstanding Office Action. Accordingly, appropriate remarks responsive to the Examiner's concerns and supportive of the patentability of the pending claim sets are presented above.

As a general comment, it appears the Office Action fails to understand or otherwise appreciate that the present invention provides a unique combination of structure that enables a more realistic presentation of waterfowl decoys for the purpose of luring waterfowl. All of the rejections contained in the Office Action reflect hindsight picking and choosing among the various elements of vastly divergent references. The mere fact that parts can be taken from one or more devices and added to another does not mean it would have been obvious to a person of ordinary skill to do so. The Federal Circuit has made it clear in case after case that there must be some explicit teaching or suggestion to combine the various elements of the various references in the particular manner of the claimed invention. In the absence of such an explicit teaching or suggestion in the art, the combination cannot be said to be obvious and therefore cannot be validly applied against the claims.

We have exactly that situation here. Nowhere in the references does one find a suggestion that a bird-repelling device (Sugimoto) be modified in a way that turns it into a bird-luring device. Nowhere in the references does one find a suggestion that the bird-repelling device of Sugimoto should be modified so that the decoy flies above the motor attachment point. Nowhere does one find a suggestion that a passive bird-luring device (Caccamo) be modified so that the decoys are rotated by a computer-controlled motor, either at, above, or below the motor attachment point. A conclusory statement that something would be obvious from a combination of multiple references is insufficient as a matter of law to support an obviousness rejection. Since the Office Action has not pointed to anything in the art which explicitly teaches or suggests the combinations of structure called for in the claims, the obviousness rejections must be withdrawn.

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Accordingly, Applicant urges the Examiner to reconsider the claims and to find that they are indeed allowable.

In the event that this response is not timely filed and an extension of time is not requested, Applicant hereby petitions for an appropriate extension of time. The fee for this extension, along with any other fees which may be due with respect to this response, may be charged to our deposit account No. 50-1971.

The Examiner's attention to and consideration of the remarks presented in this Response is greatly appreciated. If there are additional issues which can be resolved by telephone, the Examiner is invited to contact the undersigned at 918-595-4860.

Respectfully submitted,



Michael E. Sellers,
Registration No. 39,831
PTO Customer No. 28,827
GABLE & GOTWALS
100 West 5th Street, 10th Floor
Tulsa, OK 74103
Tel: (918) 595-4860